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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/672,421
Filing Date: September 26, 2003
Appellant(s): COBLE ET AL.

Daniel P. Malley
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 28, 2006 appealing from the Office action mailed December 20, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTION

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. Rejection of claim 12 is hereby withdrawn as its dependency had been previously changed to depend from indicated allowable dependent claim 10 in the amendment filed 9/26/2005. Consequently, the status of claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 1-5, 7-9, and 19-21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rugg (US patent no. 2,380,793) in view of Bell et al (US patent no. 6,545,216). Rugg discloses a ceiling fixture support assembly for mounting electrical fixtures comprising electrical box (2) including a base member (4 and 7) of disk shaped (4) with parallel beveled edges (3) with side member (2, figure 2), wherein the base member (4 and 7 together constitute the base member) has slots (10) for receiving a U-shaped mounting assembly (8) having a rectangular flat support member (13, figure 3), plural tabs (14) insert into slots. However, Rugg does not show the claimed first and second support fixture assembly.

Bell teaches a ceiling fixture support assembly for mounting electrical fixtures such as fan and lighting fixtures (col. 1, lines 20-22) comprising electrical box (18) including a base member of disk shaped (16) with parallel beveled edges (where 70 and 40 are mounted) with side member (18), first and second fixture support (40 and 70) having a shaft (52) inserted into the flat portion of the side member and with connector holes (44, 48), and mounting assembly (fasteners not shown but to be used through holes (26, 28) to couple the electrical box to the structural support member.

It would have been obvious to one of ordinary skill in the art to have provided Rugg's fixture support assembly with Bell's first and second fixture support for supporting ceiling and lighting fixtures as taught to be desirable by Bell. Regarding claim 2, Rugg's electrical box is inherently capable of receiving a cover.

Claim 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rugg (US patent no. 2,380,793) in view of Bell et al (US patent no. 6,545,216) as applied to claims 1, 6, 8, 11 above, and further in view of Reiker (US patent no. 6,207,897). Rugg and Bell combined disclosed all the claimed features of appellant's invention except for being mounted to a joist and using plural connectors to connect the flat member to the base member. Reiker teaches an electrical box ceiling fixture with U-shaped mounting assembly having tabs (521, 522) for mounting to a joist (J) wherein the flat member of the U-shaped is mounted to the base member via plural connectors (554). It would have been obvious to one of ordinary skill in the art to have mounted the ceiling fixture of Rugg and Bell to a ceiling joist via the U-shaped mounting assembly and to mount the flat member using plurality of connectors for a more secure fit as taught to be desirable by Reiker.

Allowable Subject Matter

Claims 10, 12, 13, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(10) Response to Argument

Appellant's arguments filed 9/28/2006 have been fully considered but they are not persuasive.

Appellant's argument begins on item B.

Appellant main point of argument against Rugg is that there is no base member with pair of slots. Examiner's position throughout prosecution has been that appellant's

recites a base member does not necessarily encompass a single component base member but rather would encompass a base member of plurality of components. Furthermore, the claims call for an "ceiling fixture support assembly" or an assembled ceiling fixture support. The base member 4 of Rugg does have a central opening 6 which in its assembled unit is covered by a backplate 7 having tabs 12 engaged and interlocked with the base member 4 at openings (5) and where the backplate (7) has a pair of slots (10). Examiner interpreted the claimed language of the base member as being a base plate (4) its connected backplate (7).

Appellant argues that "examiner is not entitled to rewrite a related art reference (Rugg) to suit her needs". If the word "rewrite" means "interpret" in such argument, then examiner believes she is entitled to a broad interpretation of appellant's claim language to protect the integrity of other patents and to give appellant the best patent if he or she so deserve. The question here is whether appellant's claim language has overcome the prior art of Rugg, and examiner's interpretation of appellant's claims indicate that they have not.

Appellant recites the support assembly has an electrical box with the base member in claim 1. Keeping in mind that nowhere in the claims do appellant say that the base member has to be a one piece component. Examiner's interpretation of such claimed "base member" may also encompass an assembly of components. The Rugg reference shows a two piece component of 4 and 7 at the base area of the electrical box. Examiner believes that these two components 4 and 7 of Rugg reads on the claimed base member of appellant's claimed invention. Such interpretation is believed

to be reasonable as examiner does not deviate from appellant's claim invention in anyway. Furthermore, even though the backplates 4 and 7 are of two piece base component, the end result is that the backplate member 7 has tabs (12) which when assembled engages the holes (5) on backplate 4 making the two components of the base member connected and interlocked (see Rugg, figure 1). Furthermore, Rugg does show the backplate member with a pair of slots (10) which receives plurality of tabs (14) of a mounting assembly (8); where the tabs (14) are inserted into the pair of slots (10) of the base member such that the tab members (14) and the base member (component 7 of base member) form a channel configured to receive a structural member (1) therein as seen in figure 2.

Appellant's next argument is that neither Rugg or Bell has the recited mounting assembly. As pointed out above, Rugg, the primary reference, already shows the recited mounting assembly (8) forming a channel defined by the tabs (14) and the base member (component 7 of base member). Applicant argues that the bar hanger 15 in Rug is attached to the mounting assembly (8). Examiner would like to point out that Rugg's bar hanger 15 or structural support member extends across and is within the channel between the tabs. Examiner makes no representation that Bell supplies such feature of the mounting assembly, rather, the primary reference of Rugg demonstrates the claimed mounting assembly.

The secondary reference of Bell, rather, teaches providing the claimed fixture support assembly for securing fixtures in the same electrical junction box environment.

In response to appellant's argument in item C, that there is no suggestion to combine the references of Rugg and Bell, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all of the references deals with electrical junction boxes. The suggestion or motivation to place fixtures support assembly for the purpose of support the items such as fan is disclosed in Bell. The desirability to combine the references exist. Rugg discloses that the purpose of his outlet box support is for "where it is desired to locate a wiring fixture to be mounted to the box" (page 1, col. 1, lines 5-8). Such wiring fixture is generally known in the art to mean fan fixtures, lighting fixtures, etc... Bell clearly demonstrates that such wiring fixture such as fan fixtures. The desirability is clearly known to one of ordinary skill in the art and demonstrated by Bell. The success providing a first and second fixtures (40 and 70) onto an electrical junction box is clearly demonstrated by Bell.

Appellant argues that "Rugg specifically states that the electrical box is a standardized box in use at the time of the invention was made (1943) and not directed to any fixture support mechanism". Contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem

notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Appellant argues that "Bell does not use a standardized electrical standardized box that is usable with a bar hanger" (page 10, lines 14-15). One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The question is not whether Bell's electrical junction box is usable with the bar hanger, but rather would one of ordinary skill in the art use first and second fixture supports in a junction box to support electrical fixtures.

Regarding appellant's argument that "Bell does not reference Rugg" (page 10, lines 1-2), it is not necessary that the references actually express the changes or improvements that applicant has made. The test for combining references is what the reference as a whole would have suggested to one of ordinary skilled in the art.

Regarding arguments in item D, appellant argues that neither Rugg or Bell discloses any limitations of claims 7, 8, or 10. Examiner would like to point out the claim 10 which recites the flat support member is H-shaped is not on appeal. Claim 10 was indicated as allowable if combined with the base claim. Regarding the limitations of claims 7 and 8, examiner has clearly demonstrated that Rugg discloses the base member (4 and 7 together constitute the base member) has slots (10) for receiving a U-shaped mounting assembly (8) having a rectangular flat support member (13, figure 3),

plural tabs (14) insert into slots. Such U-shaped bracket (8) with its flat support member (13) is configured to be disposed in an abutting face to face position relative to a first side of the base member when the plurality of tab members (14) are inserted into the slots and where the tab members (14) are connected to the flat support member, each tab member (14) being disposed on a second side of the base member when the plurality of tab members are inserted into the plurality of slots in its assembled position (figure 2). The flat support member (13) engages the inner side of base plate (4) to create a clamping force with the backplate (7) as is understood by appellant in his discussion of Rugg.

Regarding claim 14, appellant argues that Reiker's bracket is coupled to the flat exterior side of the box. Rugg, the base reference demonstrates the U-shaped bracket is coupled to the interior side. Reiker teaches mounting the U-shaped bracket a structural member such as a joist and to use plurality of connectors.

Regarding appellant's argument in item E, appellant states that "one of ordinary skill in the art would not be motivated to combine the base reference Rugg with Reiker because the proposed combination renders Rugg unsatisfactory for its intended purpose – i.e. mounting a standard electrical box to a bar hanger" and "Similarly the proposed combination renders Reiker unsatisfactory for its intended purpose- i.e. mounting a box to a joist." (page 13, lines 14-18). Again here appellant is attacking references individually, and one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re*

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Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Appellant argues that "*three*" (emphasis added) references was used to reject claim 14. Reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Korie Chan
Primary Examiner
Art Unit 3632

Conferees:

Carl Friedman 

Peter Cuomo 